

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-12 and 14-45 are currently pending. Claim 13 has been canceled without prejudice; and Claims 1, 15, 19, 21, 23, 26, 29, 31, 34, and 39 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-40 and 45 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,671,370 to Heinonen et al. (hereinafter “the ‘370 patent”); and Claims 41-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘370 patent in view of U.S. Patent Application Publication No. U.S. 2004/0174983 to Olschwang et al. (hereinafter “the ‘983 application”).

Amended Claim 1 is directed to a system for pushing a sender-personalized notification, comprising: (1) a sender device; and (2) a recipient device. Further, Claim 1 states that the sender device is configured to select the sender-personalized notification and a destination for the sender-personalized notification corresponding to the recipient device and to send the sender-personalized notification to the recipient device, and that the recipient device is configured to receive the sender-personalized notification and to process the sender-personalized notification based on a type of the sender-personalized notification. Further, Claim 1 has been amended to incorporate the limitations recited in dependent Claim 3, namely that the received sender-personalized notification is stored in the recipient device and a digital repository of the recipient device and an entry corresponding to the sender device. Accordingly, no new matter has been added.

Applicants respectfully submit that the rejection of Claim 1 (and dependent Claims 2-12 and 14) as anticipated by the '370 patent is rendered moot by the present amendment to Claim 1.

The '370 patent is directed to a method and apparatus for enabling a calling telephone to choose a ringtone indication to be played at a receiving telephone. As shown in Figures 2-4, the '370 patent discloses that a calling telephone may be used to select a particular ringtone to be used when placing a call. Further, the '370 patent discloses that the ringtone sounds are stored in a data file 22 associated with the telephone system and that, when the receiving telephone receives the message and the indication that a particular ringtone is desired, the selected ringtone is fetched from the data file 22 associated with the telephone system. Further, the '370 patent discloses that the fetched ringtone is then audibilized to indicate the reception of the call at the receiving telephone. Thus, the '370 patent discloses that all the possible ringtones are stored in the data file 22, which can be accessed as needed by both the calling and the receiving telephones. However, Applicants respectfully submit that the '370 patent fails to disclose that the received sender-personalized notification is stored in the recipient device in a digital repository of the recipient device in an entry corresponding to the sender device, as recited in amended Claim 1. In particular, Applicants note that the '370 patent fails to disclose that the received notification (e.g., a ringtone) is stored in the recipient device in an entry corresponding to the sender device, as recited in amended Claim 1. Rather, the '370 patent merely disclose that ringtones are available for retrieval in a data file associated with the system, but does not disclose that received ringtones are stored. Accordingly, Applicants respectfully submit that amended Claim 1 patentably defines over the '370 patent.

Independent Claims 15, 19, 21, 23, 26, 29, 31, and 34 recite limitations analogous to the limitations recited in amended Claim 1. Moreover, Claims 15, 19, 21, 23, 26, 29, 31, and

34 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 15, 19, 21, 23, 26, 29, 31, and 34 (and all similarly rejected dependent claims) as anticipated by the '370 patent are rendered moot by the present amendment to the independent claims.

Amended Claim 39 is directed to a mobile switching center, comprising: (1) a processor; and (2) a computer readable medium encoded with processor readable instructions than when executed by the processor implement a sender personalized notification enabling mechanism configured to determine if a sender of a call sent a sender-personalized notification as a separate message at substantially a same time as placing the call, and a sender personalized notification pushing mechanism configured to send the sender personalized notification at substantially the same time as the call is routed to a recipient of the call.

Applicants respectfully submit that the '370 patent fails to disclose a sender personalized notification enabling mechanism configured to determine if a sender of a call sent a sender-personalized notification as a separate message at substantially the same time as placing the call, as recited in amended Claim 39. Rather, the passage cited by the Examiner (column 8, line 66 through column 9, line 7 of the '370 patent) discloses that the '370 system determines whether or not selection of a ringing notification was included with the incoming call. However, the '370 patent fails to disclose determining if a sender of a call sent a sender personalized notification as a separate message at substantially a same time as placing the call, as recited in amended Claim 39. Accordingly, Applicants respectfully submit that the rejection of Claim 39 (and dependent Claim 40) as anticipated by the '370 patent is rendered moot by the present amendment to Claim 39.

Regarding the rejection of dependent Claims 41-44 under 35 U.S.C. § 103(a), Applicants respectfully submit that the '983 application fails to remedy the deficiencies of the '370 patent, as discussed above. In particular, Applicants respectfully submit that the '983 patent fails to disclose that a recipient device is configured to determine if a phonebook includes an entry for the sender device and to store the sender personalized notification as a custom notification corresponding to an entry associated with the sender device such that the notification received as the sender personalized notification will be played by the recipient device when the recipient device receives a call from the sender device, as recited in Claim 41. Rather, the '983 application merely discloses a tone providing system 206, which is associated with the switch device 203, and is not a part of the receiver 202. Further, the '983 patent merely discloses that the tone providing system 206 provides personalized configurable call progress tones according to the specific call originator 201.

In addition, Applicants respectfully submit that the Office Action fails to provide adequate motivation to combine the teachings of the '370 patent and the '983 application, in the manner suggested in the Office Action. As motivation for combining the cited references, the Office Action refers to paragraph 3 of the '983 application, which is a statement of the field of the invention of the '983 application, i.e., "a method and system for providing configurable call progress tones in a telephony system." However, Applicants respectfully submit that this is not proper motivation for combining the '983 application and the '370 patent. One of ordinary skill in the art would not have been motivated by a statement of the field of the invention of the '983 application to modify the '370 patent in the manner suggested in the Office Action. Paragraph 3 of the '983 patent merely indicates the field of the invention and one of ordinary skill in the art would only assume that the inventors of the '983 application were successful in providing configurable call progress tones in a telephoning system, and would not be motivated to modify either the '983 application or the

'370 patent based on the statement of the field of the invention. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of dependent Claims 41-44 should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 15, 19, 21, 23, 26, 29, 31, 34, and 39 (and all associated dependent claims) patentably define over any proper combination of the '370 patent and the '983 application.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Kurt M. Berger  
Thomas J. Fisher  
Attorney of Record  
Registration No. 44,681  
Kurt M. Berger, Ph.D.  
Registration No. 51,461

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 06/04)

I:\ATTY\KMB\246436US-AM.DOC